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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 10/070,782   | 03/12/2002  | Takafumi Hashimoto   | 1064-02                   | 9611             |
| 35811  | 7/98        | 01/29/2004           |                           |                  |
| IP DEPARTMENT OF PIPER RUDNICK LLP<br>3400 TWO LOGAN SQUARE<br>18TH AND ARCH STREETS<br>PHILADELPHIA, PA 19103 |             |                      | EXAMINER<br>KUMAR, PRIETI |                  |
|  |             |                      | ART UNIT<br>1751          | PAPER NUMBER     |

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

|                               |                                  |
|-------------------------------|----------------------------------|
| Application No.<br>10/070,782 | Applicant(s)<br>HASHIMOTO ET AL. |
| Examiner<br>Preeti Kumer      | Art Unit<br>1751                 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- IFNO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

**DETAILED ACTION**

***Final Rejection***

1. Claims 1-4 and 6-13 are pending.
2. The objection to claims 1-13 is withdrawn in light of applicant's amendment to the claims.
3. The rejection of claims 1-13 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in light of applicant's amendment to the claims.
4. The rejection of claims 1-13 under 35 U.S.C. 102(b) as anticipated by Nakashima et al. (US 5,876,466) is withdrawn upon reconsideration of the prior art.
5. The rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al. (US 5,876,466) is withdrawn upon reconsideration of the prior art.
6. The rejection of claims 1-3 and 6-13 under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al. (US 5,876,466) is maintained for the reasons recited in the previous office action dated 7/2/2003 and further described below.
7. The rejection of claims 1-4,6 and 8 under 35 U.S.C. 103(a) as being unpatentable over Akasawa (US 5,679,418) is maintained for the reasons recited in the previous office action dated 7/2/2003 and further described below.

***Response to Arguments***

8. Applicant's arguments filed November 10, 2003 have been fully considered but they are not persuasive. Applicants urge that Nakashima et al. and the teachings of Akasawa fail to teach or suggest the claimed limitation wherein the polyurethane

employs polymer diol which contains from 50wt% to 90wt% polycarbonate diol as recited in the instant claim 1.

Although Nakashima is silent as to the percentage of polycarbonate diol as recited by the instant claims, Nakashima et al. teach examples of the polyurethane to be incorporated in the fiber entangled nonwoven fabric include polyester-polyurethane, polyether-polyurethane, polyester-ether-polyurethane, polylactone-polyurethane and polycarbonate-polyurethane. The polymers may be obtained by solution polymerization, melt polymerization or bulk polymerization of at least one polymer diol which has an average molecular weight of 700 to 3000 and is selected from the group consisting of polyester diols, polyether diols, polyesterether diols, polylactone diols and polycarbonate diols. See co.5, ln.35-45. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to arrive at a suede like sheet comprising poly carbonate diol because Nakashima et al. suggest a suede like sheet comprising poly carbonate diol in general.

Contrary to Applicant's argument that Akasawa fail to teach or suggest the claimed limitation wherein the polyurethane employs polymer diol which contains from 50wt% to 90wt% polycarbonate diol as recited in the instant claim 1, examiner draws attention to the abstract where Akasawa teaches a polyurethane composition suitable for producing leather-like sheets having a soft hand and excellent durability and being dyeable with acid dyes comprising a mixture of: a first polyurethane (a) obtained by reacting: an intermediate product diol (D) with both ends thereof substantially being OH and obtained by reacting a tertiary amino group-containing diol (A), a polymer diol (B)

having a number average molecular weight of 500 to 3,000 selected from the group consisting of polyesters, polycarbonates, polylactones and polyethers and an organic diisocyanate (C1), in such stoichiometric amounts as to make the molar ratio of NCO/OH 0.5 to 0.99, a low molecular weight diol (E), and diphenylmethane-4,4'-diisocyanate (C2), and a second polyurethane (b) having a solubility in toluene of not more than 50% by weight and obtained by reacting a polymer diol having structural units from dimethylsiloxane and a second organic diisocyanate and having a number average molecular weight of 1,000 to 10,000, the ratio of said second polyurethane (b) to said first polyurethane (a) being in a range of 0.5 to 50% by weight. See abstract and col.4,ln.18-44.

#### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9309.

Preeti Kumar  
Examiner  
Art Unit 1751

PK



Signature of Preeti Kumar, Examiner, Art Unit 1751.